

REMARKS/ARGUMENTS

By the foregoing amendment, the specification has been corrected in accordance with the Examiner's suggestions and the claims have been amended similarly in accordance with the Examiner's suggestions. Claim 1 has also been amended to make it clear that the male threads are straight and non-tapered similarly as the female threads are straight and non-tapered.

The rejection of the claims as unpatentable over Carter U.S. patent No. 4,537,426 is respectfully traversed. The Examiner correctly characterizes the Carter female fitting as having "tapered threads". Obviously the male threads 24 of Carter are similarly tapered or otherwise the male and female threads would not be threadedly engageable with one another to connect the fittings to one another. The Examiner also points out that there are many different thread types that are well known. From that, the Examiner concludes that it "would have been an obvious matter of design choice to modify Carter's fittings to include a given thread type, including straight and non-tapered threads." The predicate for the conclusion of obviousness according to the Examiner is that the inclusion of a given thread type, e.g. the straight and non-tapered threads is "based on the suitability and/or user preference for a particular application." Applicants submit, however, that this is not the proper test for obviousness within the meaning of 35 U.S.C. 103, begs the question of obviousness and, that a "design choice" is an indicator of non-obviousness rather than obviousness.

That many and various types of threads between male and female parts are well known is not contested by applicant. In the present instance, however, applicant has provided straight non-tapered complementary male and female threads for specific purposes. For example, this specific type of thread as employed on the male and female fitting in conjunction with the gasket seal of the present invention enables free orientation of the male and female threads about their

relative rotational axes while at the same time enables sealing in final securement of the pipes to one another. That is, physical connection between the two pipes is provided by the straight non-tapered threads enabling relative rotation of the pipes, particularly when near their final orientation relative to one another, while at the same time the pipes may be sealed to one another. In short, the connecting and sealing aspects of the connection system are independent of one another using non-tapered straight threads. Tapered threads as in Carter cannot provide that independent action.

The Examiner bases the conclusion of obviousness on the well-known existence of many different thread types. Applicant does not disagree that there are many different thread types. There must, however, be a teaching or suggestion to select the specifically claimed element, i.e. straight non-tapered male and straight non-tapered female threads. The Federal Circuit has consistently and uniformly held that in order for there to be a *prima facie* case of obviousness, there must be a suggestion that is clear from the prior art itself for a modification or combination of references to provide the claimed invention. For example, see the very clear decision in the case of *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999), wherein the Court stated that "combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventors disclosure as a blue print for piecing together the prior art to defeat patentability—the essence of hindsight...". The Court in *In re Rouffet*, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) was even more instructive on this point as follows:

[v]irtually all [inventions] are combinations of old elements. ... ("Most, if not all, inventions are combinations and mostly of old elements"). Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate

patentability, very few patents would ever issue. Further, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as the blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be “an illogical and inappropriate process by which to determine patentability.” .(citation omitted)

To prevent the use of hindsight based on the invention to defeat patentability of the invention, this Court requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the invention and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.

As noted previously applicants do not contest that straight non-tapered threads *per se* may be well known. However simply identifying that as a fact does not permit the Examiner to use applicants' application and claims as a teaching for replacing the tapered threads of Carter with straight non-tapered threads as claimed. Moreover, the Examiner has demonstrated no motivation to change or alter the threads of Carter and indeed without knowledge of the claimed invention a person of skill in the art would not be led to make such alteration of the Carter threads. The Examiner's comment that the substitution would be based on suitability and/or user preference for a particular application is not well taken since it is only applicants' specification and claims which offer a choice, and then only in comparison with the Carter disclosure. However, applicants' disclosure is not part of the prior art and is not available to the Examiner as a suggestion or motivation to make two choices. Indeed, the lack of any commentary in Carter indicating other types of threads may be used certainly cannot lead to the conclusion of obviousness within the meaning of 35 U.S.C. 103.

The rejection of the dependent claims are traversed for the reasons noted above.

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Accordingly, reconsideration and allowance of the claims presently pending is respectfully requested.

Respectfully submitted,

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